

Serial No.: 09/697,822
Filing Date: October 26, 2000

Docket No. 12286RRUS01U / 22171.375
Customer No.: 27683

REMARKS

Claims 1-42 remain in this application. Claims 1, 12-15, 19, and 26-27 are amended. No new matter is added as a result of the above amendments. Reconsideration of this application in light of the above amendments and the following remarks is requested.

Rejections Under 35 U.S.C. § 102(e), Claims 1-3, 5-8, 12, 14-15, 17, 18-20, 22-24, and 26

Claim 1

Amended claim 1 recites:

1. A method for lawful interception of communication related information comprising:

selecting a location for intercepting a communication in a packet data network based at least in part on an event type;

detecting the occurrence of a predetermined event in said packet data network;

gathering communication relating information of said communication at said selected location based at least in part on a type of the detected event in response to said detection of the occurrence of said event; and

transmitting said gathered communication related information to at least one law enforcement agency. (Emphasis added).

Claims 1-3, 5-8, 12, 14-15, 17, 18-20, 22-24, and 26 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application No. 2002/0150096 to Sjoblom. This rejection is respectfully traversed.

The PTO provides in MPEP § 2131 that

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, with respect to claim 1, to sustain this rejection the Sjoblom reference must contain all of the above claimed elements of the claim. However, contrary to the examiner's position that all elements are disclosed in the Sjoblom reference, the reference does not disclose

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"gathering communication relating information of said communication at said selected location based at least in part on a type of the detected event in response to said detection of the occurrence of said event."

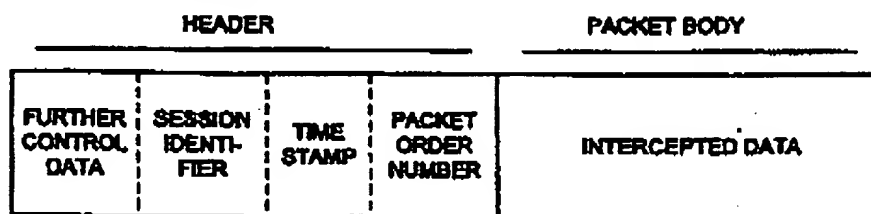
The examiner alleges in the rejection of claim 12 that Sjoblom discloses these features in paragraphs 60-61, which reads as follows:

Fig. 3 shows the interception node (GSN, i.e. GPRS Support Node) 3 in more detail. It is noted that this can be a SGSN (Serving GPRS Support Node), a GGSN (Gateway GPRS Support Node) or any other suitable node which can be used for incorporating an interception function therein. Reference numeral 31 denotes the GSN node itself, which is adapted to intercept a communication performed via the corresponding GPRS (packet switched) network. Reference numerals 32 and 33 denote an IRI detector and a CC detector, respectively.

The IRI detector 32 is adapted to detect the necessary interception related information associated to the communication to be intercepted and creates data packets (as shown in Fig. 2) in which the interception related information (IRI) is included in the user data and in which the header provides room for the session identifier and the order number.

Paragraphs 60-61, Sjoblom.

Fig. 2 of Sjoblom is shown below:



In the above section and in Fig. 2, Sjoblom discloses that an IRI detector detects the necessary interception related information associated to the communication to be intercepted and creates data packets according to the format in Fig. 2. However, Sjoblom does not disclose that the IRI detector gathers the interception related information based on a type of the detected event. In fact, nowhere in reference does Sjoblom discuss the type of a detected event. Sjoblom

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merely disclose gathering all necessary interception related information (intercepted data) from the communication and generating a data packet that includes a header identifying the session and the order of the packet. This is different from the features of claim 1, in which communication related information is gathered based on the type of the detected event, for example, gathering information related to call signaling based on a call signaling event type and gathering information related to path establishment or path release based on a path establishment and path release event type. Sjoblom does not disclose such features. To the contrary, in paragraph 64, Sjoblom is only interested in "providing an ordering means that generate ordering numbers for the IRI and CC packets," such that the IRI and CC packets may be correctly ordered at the Law Enforcement Agency. Therefore, Sjoblom does not disclose the features of amended claim 1.

With regard to independent claims 19 and 26, which recite subject matter similar to amended claim 1, Sjoblom also does not disclose "collecting communication related information of a communication in said packet data network in response to said detection of an event based at least in part on a type of said detected event." As discussed above in arguments presented for claim 1, Sjoblom merely discloses gathering interception related information and generates a data packet. But Sjoblom fails to mention anything about an event type, let alone gathering communication related information based on an event type. Therefore, Sjoblom also does not disclose the features of claims 19 and 26.

By virtue of their dependencies on claims 1 and 19, Sjoblom also fails to disclose the features of dependent claims 2-3, 5-8, 12, 14-15, 17, 18, 20, and 22-24. Therefore, the rejection to claims 1-3, 5-8, 12, 14-15, 17, 18-20, 22-24, and 26 is not supported by Sjoblom and should be withdrawn.

Rejections Under 35 U.S.C. §103(a), Claims 9, 11, 13, 25, and 27-42

Claims 9, 11, 13, 25, and 27-42 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sjoblom in view of U.S. Patent No. 6,470,075 to Prieur. Applicants traverse this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 27.

As the PTO recognizes in MPEP § 2142:

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... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The Sjoblom and Prieur references cannot be applied to reject claim 27 and under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. Neither Sjoblom nor Prieur discloses or suggests "a surveillance access point (SAP) operable to communicate with said node, wherein said SAP intercepts a communication upon the detection of said event in said packet mode data network, and wherein said SAP gathers communication related information of said intercepted communication based on a type of the event and provides said gathered information to a law enforcement agency," as is claimed in claim 27, it is impossible to render the subject matter of claim 27 as a whole obvious, and the explicit terms of the statute cannot be met.

The examiner admits that Sjoblom does not disclose such features, but alleges that Prieur discloses these features at column 3, line 60 to column 4, line 7, column 4, lines 54-56, and column 5, line 49 to column 6, line 2, which read as follows:

The access sub-function 12, shown in Fig. 1, is typically embodied as one or more Intercept Access Point (IAPs) 14, connected to the appropriate nodes of the cellular telecommunication network 10, as shown in Fig. 2, or to the PSTN nodes (not shown). Typically, these nodes may be mobile switching centers

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(MSCs) 16, as shown in Fig. 2, since MSCs 16 are the core of the cellular telecommunication network, and voice and data communication always go through at least one MSC where they are most likely to be intercepted. The IAP is typically provided as a node within the cellular telecommunication network 10, or the PSTN 11, where the communications of a monitored subscriber are accessed. Alternatively, the IAP may be co-located with the MSC 16.

Column 3, line 60 to column 4, line 7, Prieur.

Therefore, it is logical that IAP 14 is connected to the MSC 16, in order to be able to intercept communications of monitored subscribers.

Column 4, lines 54-56, Prieur.

Continuing to refer to Fig. 2, once the call content and the call identification information are intercepted by the IAP 14, they are typically delivered, through the delivery function 18 to the Law Enforcement Agency 30. As stated, the delivery function 18 may also be provided as a software tool implemented as part of the MSC 16 or the IAP 14. Alternatively, the delivery function may comprise dedicated hardware circuitry for delivering the intercepted information to the LEA 30. As described in the foregoing, the delivery function 18 is associated with the delivery network comprising call content channel 32 for delivering the call content information, such as the voice and data information, and the call data channel 34 for delivering the call identifying information.

The delivery function 18 delivers the intercepted information of the monitored subscriber to LEA 30 (only one LEA is shown on Fig. 2, although various LEAs may be connected to the same cellular telecommunication network 10). A collector module 36 performs the collection function 20 within the LEA, before forwarding the intercepted information to the LEA administration 26.

Column 5, line 49 to column 6, line 2, Prieur.

Fig. 2 of Prieur is shown below:

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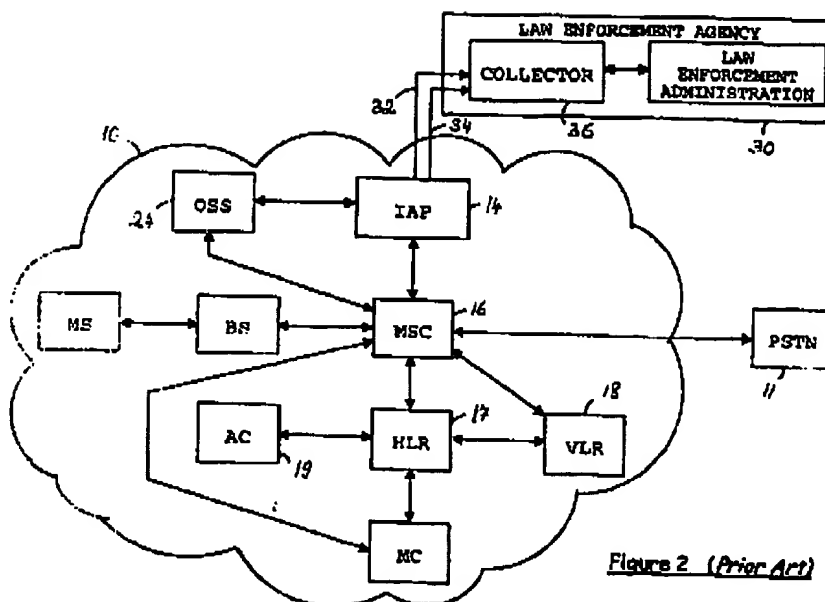


Figure 2 (Prior Art)

In the above sections and in Fig. 2, Prieur merely discloses an IAP that delivers intercepted information to the Law Enforcement Agency via the delivery function and a collector module within the LEA that performs collection function 20, which collects and analyzes the intercepted communication and the call-identifying information of the monitored subscribers for a particular LEA (column 4, lines 20-24). However, nowhere in the reference does Prieur mention that a SAP "gathers communication related information of said intercepted communication based on a type of the event," as recited in claim 27. To the contrary, Prieur specifically discloses, at column 4, lines 39-43, that "the collection sub-function 20 is under the responsibility of the LEAs. Therefore, it is the LEAs that collect the information sent by the cellular operators from the delivery sub-function 18." Thus, instead of a SAP that gathers the communication related information, Prieur discloses that the information is collected by the LEAs. Since Prieur does not disclose a SAP that gathers communication related information, Prieur does not and would not disclose a SAP that gathers communication related information based on a type of the event. Therefore, neither Sjoblom nor Prieur discloses or suggests the features of claim 27.

In addition, the examiner alleges that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Sjoblom to include the features of performing the functionalities as taught by Prieur in order for the LEAs to find

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potentially incriminating information relating to the monitored subscribers in real time without prolonged delay. Applicants respectfully disagree.

Sjoblom merely discloses gathering all necessary interception related information (intercepted data) from the communication and generating a data packet. There is no mention of a type of the event, let alone gathering interception related information based on a type of the event. Prieur, on the other hand, merely discloses a collector module within a LEA that collects intercepted information, not a SAP that gathers communication related information. Therefore, Prieur does not and would not disclose a SAP that gathers communication related information based on the event type. One of ordinary skill in the art would not have been led to modify the teachings of Sjoblom to include Prieur's collector module, because Prieur's collector module for collecting communication information is within a LEA, not a SAP. In addition, neither reference mentions gathering communication related information based on an event type. Therefore, one of ordinary skill in the art would not have been led to include the feature of gathering communication related information based on the event type, as alleged by the examiner.

Accordingly, for at least this reason, Sjoblom and Prieur are insufficient to provide a *prima facie* case of obviousness with regard to claim 27.

For the reasons described above, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. The Combination of References is Improper

There is still another reason why the Sjoblom and Prieur references cannot be applied to reject claim 27 under 35 U.S.C. § 103(a).

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

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Here, neither Sjoblom nor Prieur discloses, or even suggests, the desirability of the combination since neither discloses "a surveillance access point (SAP) operable to communicate with said node, wherein said SAP intercepts a communication upon the detection of said event in said packet mode data network, and wherein said SAP gathers communication related information of said intercepted communication based on a type of the event and provides said gathered information to a law enforcement agency" as is claimed in claim 27.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 27. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

For the reasons described above, Sjoblom and Prieur do not render the claims *prima facie* obvious, and the rejections of claims 9, 11, 13, 25, and 27-42 under 35 U.S.C. §103 should be withdrawn.

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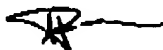
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Conclusion

It is clear from all of the foregoing that independent claims 1, 19, 26, and 27 are in condition for allowance. Dependent claims 2-18, 20-25, and 28-42 depend from and further limit independent claims 1, 19, and 27 and therefore are allowable as well.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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